



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,880	11/26/2001	Yoshiaki Nanko	SN-US015166	3242

22919 7590 09/03/2004

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 20TH STREET, NW, SUITE 700
WASHINGTON, DC 20036-2680

EXAMINER

MCANULTY, TIMOTHY P

ART UNIT PAPER NUMBER

3682

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,880

Applicant(s)

NANKO, YOSHIAKI

Examiner

Timothy P McAnulty

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10, 15, 20, and 21 is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-13, 16-19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the:

- a. first and second rear surfaces of the first and second mounting flanges being spaced apart by a distance larger than a distance between front and rear planes as claimed in claim 1, and
 - b. first and second rearward surfaces being spaced apart by a distance that is about one half of the maximum axial length of the chain guide as claimed in claim 2, and
 - c. the rear mounting flange of the chain guide being located at least partially rearwardly of a longitudinal center point of the chain guide as claimed in claim 20,
- must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

Art Unit: 3682

by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. Claims 1-8, 11-13, 16-19, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 11, 12, 16, 18, and 19, the specification does not disclose or describe said first and second mounting flanges having respective first and second rear surfaces that are spaced apart by a distance larger than a space between a front and rear plane wherein said front and rear planes are defined as in claim 1. The specification in lines 17-23 of page 12 discloses the preferred distance, L3, between said front and rear surfaces as being 49.2mm and at least 45.0mm. The specification in lines 23-30 of page 11, the radius of curvature of the mounting flange as being preferably 39.4mm. As defined by claim 1, the front and rear planes are separated by a distance equal to a diameter of the mounting flange or, based upon preferable dimensions, 78.8mm. Even considering that the mounting flange radius of curvature can be adjusted dependent on particular needs, there is no specific disclosure that any adjustment thereof would produce the claimed invention; any adjustment to produce the claimed invention would require the application of subject matter not contained within the specification. Accordingly, the preferred embodiment of the present invention does not meet the limitations of claim 1, and as such, the specification does not disclose the claimed invention.

Regarding claims 2-8, 13, and 17, the specification does not disclose or describe said first and second flanges having respective first and second rearward surfaces spaced apart by a distance that is about one half of the maximum axial length of the chain guide. The specification is silent as to any relative dimensional relationship between the first and second flanges and the chain guide. At best, figure 4 of the present invention shows the first and second flanges and the chain guide in a structural relationship. The specific relationship as claimed in claim 2, however, cannot be ascertained from the figure. The rearward surfaces of the respective first and second flanges are not shown and any comparison as to relative lengths is based upon mere speculation. Accordingly the specification does not disclose the claimed invention.

Regarding claim 22, the specification does not disclose or describe said first mounting flange of the chain guide being located at least partially rearward of a longitudinal center point of the chain guide. At best, figure 5 of the present invention shows a longitudinal view of the chain guide, however, the specific structural relationship cannot be ascertained from the drawing. Furthermore, the specification is silent with regards to any structural relationship between the first mounting flange of the chain guide and a longitudinal center. Accordingly, the specification does not disclose the claimed invention.

Response to Arguments

3. Applicant's arguments, filed 16 June 2004, with respect to claims 1, 11, 12, 16, 18, and 19 have been fully considered and are persuasive as to some of the remarks. Namely, applicant correctly asserts that there is no teaching to provide the majority of the larger mounting flange outside the mounting area defined by the front and rear planes. The combination of Kondo '425 in view of Juy '012 as set forth in the Non-final Office action mailed 04 May 2004 makes

Art Unit: 3682

obvious the modification to provide a first mounting flange larger than a second mounting flange wherein the first mounting flange is located outside of a similarly defined mounting area.

Modifying the first flange to be larger, however, will not necessarily modify the first flange to be majorily outside of the mounting area; i.e., the first flange could be modified to be larger either into or out of the mounting area with no specific teaching to make one modification over the other. The non-obviousness is further evidenced by the teachings of Juy '012 that show the larger flange to be within the mounting area.

Applicant's arguments, filed 16 June 2004, with respect to claims 2-8,13, and 17 have been fully considered but are not persuasive. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ (CCPA 1972); *In re McLaughlin*, 170 USPQ 209 (CCPA1971).

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Accordingly, the reference combination of Kondo '425 in view of Juy '012 as set forth in the Non-final Office action mailed 04 May 2004 is proper.

Allowable Subject Matter

4. Claims 9,10,15,20, and 21 are allowed.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P McAnulty whose telephone number is 703.308.8684. The examiner can normally be reached on Monday-Friday (7:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703.308.3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3682

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tpm



DAVID A. BOCCI
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 3600